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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,429	09/28/2000	Werner Zobel	655.00931	8171
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Wood Phillips Van Santen Clark & Mortimer 500 West Madison Street Suite 3800 Chicago, IL 60661		EXAMINER FORD, JOHN K		
		ART UNIT PAPER NUMBER		
		3753		
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14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,429

Applicant(s)

Zobel et al.

Examiner

FORD

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Applicants' responses of January 12, 2004 (Paper No. 13) and December 11, 2003 (Paper No. 11) have been studied carefully.

The Examiner addresses counsel's remarks in Paper No. 11 in the order of presentation.

Counsel has stated that the underlying disclosure of EP '217 is not prior art to the best of his knowledge. Examination proceeds on that basis. The Examiner assumes that counsel made this statement after having made appropriate inquiry to those persons most knowledgeable regarding EP '217. Given that the bulk of the relevant prior art is from overseas, it appears that U.S. counsel would be the least likely knowledgeable party. Regarding the Examiner's comments about the various assignees, they illustrate that there is at least a possibility that this technology was bought and sold in Europe before Modine acquired the technology. Again, applicants would be apparently for more knowledgeable than counsel with regard to these matters, as counsel has represented that he knows essentially nothing regarding the historical context of the acquisition of this technology by the various predecessor assignees.

Regarding the discussion of priority under 35 U.S.C. 119, counsel is requested in the future to refrain from introducing legal arguments (i.e. regarding "effective filing date" under 35 U.S.C. 119, moving the 35 USC 102(b) bar back an extra year as argued in applicant's January 14, 2003 response, page 5, first paragraph) that are contrary to prevailing law, without alerting the reader to the fact that they are contrary to prevailing law. Less experienced examiners, it is submitted, are likely to be confused by such

arguments and the file wrapper would be made less than clear if this matter was not cleared up during prosecution.

Regarding DE '728, the translation is again appreciated. Regarding DE '867, the Examiner respectfully disagrees with counsel on several points. The significance of DE '867 was not readily identifiable to a non-German speaker until the translation was produced. Regarding the assertion that it should have been produced, counsel's reading of "malevolent intent" into the Examiner's remarks is not understood. The Examiner's only concern is that the most relevant prior art that applicants, assignee and counsel know of be produced as early as possible, preferably before first action. The consequence of belated production is that the PTO goals of compact prosecution are thwarted. It is believed that DE 29504867 was made of record in other applications related to this technology that are being prosecuted by other attorneys at counsel's law firm.

Regarding the request at the top of page 4, of Paper No. 11 that the Examiner withdraw his statement on the record to avoid casting any doubt on validity of any resulting patent, the Examiner is eager to state that whatever inference regarding "intent" that counsel may have drawn from any statement made by Examiner is in error. The Examiner is only interested in having the relevant prior art made of record as early as possible, preferably before first action so that the PTO's goals of compact prosecution are realized.

Turning to the discussion of the prior art beginning at the top of page 6, of Paper No. 11, it is clear that the two German Patents (DE'798 and DE'867) disclose cores with

widths (not lengths) answering to applicants' use of the term "width" in the claims. While the Examiner used the word "length" consistent with the '909 patent to describe the dimension involved, it is respectfully submitted that the references (DE '728 and DE'867) both teach cores with different "widths" as used in applicant's claims and that upon closer inspection the '909 patent does as well. Since Mr. Ehlers is a named inventor in both this application and the '909 patent, counsel should contact him to see if the ambiguity of language regarding the semantics used in the '909 patent can be resolved. In the Examiner's view, it is very clear that Ehlers '909 states that cooler 23 has a length dimension shorter than the length dimensions of coolers 25 and 26 which counsel has pointed out is an erroneous description of Figure 2. Looking at Figure 1 of Ehlers '909, however, it is clear that the dimension being discussed in Ehlers '909 is the "length" of the core along the axis 29 (what applicants call "width") not perpendicular to it. See the rectangular depiction of heat exchangers 25, 26 at the bottom of Figure 1 and the much "wider" core at the top of Figure 1.

It is submitted that if there is any ambiguity about the "width" of the cores being capable of being different in Ehlers '909, it is certainly put to rest by the teachings of DE '728 and even more so by the teachings of DE '867, counsel's statements to the contrary notwithstanding. Even adjusting for the fact that the perspectives change in DE '867, the top core 3 is clearly shorter than the side core 2, in applicants' claimed "width" direction. Regarding DE'867, Figures 2, 4 and 5 clearly show that core 13 has a smaller width than cores 9 and 10. As the Examiner interprets claim 1, the claim is satisfied by this relationship.

In short, counsel's arguments on this point are not convincing.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Ehlers et al. (USP 6,164,909 or WO 98/45600) and either DE 19724728 or DE 29506867.

Ehlers et al. (USP '909 or WO'600) disclose a radial fan surrounded by at least three heat exchangers in a box-like structure.

The heat exchangers in Ehlers are different sizes with: "length dimensions of the coolers (23,24,25) are not all the same. For example, the length dimension of the cooler (23) is shorter than the length dimension of both the coolers (25) and (26)." See USP 6,164,909 col. 3, lines 17-20 and corresponding disclosure (in German) in WO 98/45600.

It is clear that the two German Patents (DE'798 and DE'867) disclose cores with widths (not lengths) answering to applicants' use of the term "width" in the claims. While the Examiner used the word "length" consistent with the '909 patent to describe the dimension involved, it is respectfully submitted that the references (DE '728 and

DE'867) both teach cores with different "widths" as used in applicant's claims and that upon closer inspection the '909 patent does as well. Since Mr. Ehlers is a named inventor in both this application and the '909 patent, counsel should contact him to see if the ambiguity of language regarding the semantics used in the '909 patent can be resolved. In the Examiner's view, it is very clear that Ehlers '909 states that cooler 23 has a length dimension shorter than the length dimensions of coolers 25 and 26 which counsel has pointed out is an erroneous description of Figure 2. Looking at Figure 1 of Ehlers '909, however, it is clear that the dimension being discussed in Ehlers '909 is the "length" of the core along the axis 29 (what applicants call "width") not perpendicular to it. See the rectangular depiction of heat exchangers 25, 26 at the bottom of Figure 1 and the much "wider" core at the top of Figure 1.

It is submitted that if there is any ambiguity about the "width" of the cores being capable of being different in Ehlers '909, it is certainly put to rest by the teachings of DE '728 and even more so by the teachings of DE '867, counsel's statements to the contrary notwithstanding. Even adjusting for the fact that the perspectives change in DE '867, the top core 3 is clearly shorter than the side core 2, in applicants' claimed "width" direction. Regarding DE'867, Figures 2, 4 and 5 clearly show that core 13 has a smaller width than cores 9 and 10. As the Examiner interprets claim 1, the claim is satisfied by this relationship.

Both DE'728 and DE'867 teach different length [applicant's "width"] heat exchangers oriented in offset relation as claimed. To have projected the different length cores 23, 25 and 26 of Ehlers et al. to project forwardly and/or rearwardly of one another would have been obvious in view of the respective teachings of DE'728 (Fig 1) and DE'867 (Figs 1-7).

Claims 1, 4, 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1, 4, 6, 7 and 10 above, and further in view of DT 2716997 or Fachbach (USP 3,978,919).

Each of these references explicitly teaches journaling the fan to the rear panel of a heat exchange system analogous to that disclosed in the prior art discussed above. To the extent that Ehler's et al. (USP '909 or WO'600) lacks explicit disclosure of journaling it is submitted that it must exist to permit V-belt 28 to be tensioned. Only out of an abundance of caution does the examiner rely on DT'997 or Fachbach to explicitly teach what is inherently disclosed in Ehlers et al., namely journaling to the rear wall of the fan box an advantageous location in not blocking air flow.

Claims 2, 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the prior art as applied to claims 1, 4, 6 and 7 above, and further in view of Beasley et al. (USP 4,730,669).

Beasley in Figure 12 shows a charge air cooler core (col. 5, line 66- col. 6, line 3) with a core depth significantly greater than the cooling radiator shown in Figure 1. Charge air coolers cooled by air are known to be relatively large as evidenced by Emmerling (USP 4,317,439) col. 1, lines 28-43. Emmerling forms no part of this rejection except to show what is deemed common knowledge in this art.

To have used the relatively thick charge air cooler core disclosed in Beasley Figure 12 in place of the top mounted (horizontal) charge air core of the prior art discussed above for the purpose of improved cooling of the charge air would have been obvious to one of ordinary skill in the art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 6, 7 and 10 are rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 or claims 1-

18 of U.S. Patent No. 6,564,857 or 6,164,909, respectively in view of either DE 19724728 or DE 29504867.

Both DE '728 and DE'867 teach different length heat exchangers oriented in offset relation as claimed. To have projected the different cores claimed in USP '857 or USP '909 to project forwardly and /or rearwardly of one another would have been obvious in view of the respective teachings of DE'728 (Fig 1) and DE '867 (Figs 1-7).

Claims 2, 3 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 or claims 1-18 of U.S. Patent No. 6,564,857 or 6,164,909, respectively in view of DE'728 or DE'867 and Beasley.

The rejection of claims 1,4,6 and 7 is explained above. Beasley in Figure 12 shows a charge air cooler core (col. 5, line 66- col. 6, line 3) with a core depth significantly greater than the cooling radiator shown in Figure 1. Charge air coolers cooled by air are known to be relatively large as evidenced by Emmerling (USP 4,317,439) col. 1, lines 28-43. Emmerling forms no part of this rejection except to show what is deemed common knowledge in this art.

To have used the relatively thick charge air cooler core disclosed in Beasley Figure 12 in place of the top mounted (horizontal) charge air core of USP 6,564,857

discussed above for the purpose of improved cooling of the charge air would have been obvious to one of ordinary skill in the art.

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication should be directed to John Ford at telephone number 703-308-2636.

Application/Control Number: 09/672,429
Art Unit: 3753

Page 11

Ford/DI

March 25, 2004



John K. Ford
Primary Examiner